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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,494	08/29/2006	Kazuo Tagawa	07481.0045	5119

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EXAMINER	
VASISTH, VISHAL V	
ART UNIT	PAPER NUMBER
1797	
MAIL DATE	DELIVERY MODE
12/15/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/566,494	TAGAWA ET AL.	
	Examiner	Art Unit	
	VISHAL VASISTH	1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 August 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *10-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/31/2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 10 is objected to because of the following informalities: the claim reads, "dibasic acid and a monohydric alcohols," it should read "dibasic acid and a monohydric alcohol." Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Seiki et al., US Patent No. 5,403,503 (hereinafter referred to as Seiki).

Seiki discloses a refrigerator oil composition comprising, a polyoxyalkylene glycol derivative (a predetermined base oil) (Col. 2/L. 21-49) and the reaction product of a monohydric aliphatic alcohol (monohydric alcohol) and a polybasic carboxylic acid wherein the polybasic carboxylic acids are preferably aliphatic saturated dicarboxylic acid having 2 to 12 carbon atoms (chain-like dibasic acid) (Col. 3/L. 59-67).

The composition of Seiki further comprises an aliphatic acid partially esterified with a polyhydric alcohol wherein the aliphatic acid can be a monobasic fatty acid (Col. 5/L. 60-65 and Col. 8/Table 1) (esters of polyhydric alcohol and monobasic fatty acid as recited in claim 12) and either a phosphate or phosphite compound or both.

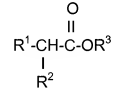
Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 10, 12-14 and 16-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Kawahara et al., US Patent No. 6,667,285 (hereinafter referred to as Kawahara). The examiner does want to note that this is the US national phase application (therefore in English) of WIPO application No. WO/2000/068345 which is in Japanese but does have a 102(b) date.

Kawahara discloses a lubricating oil composition for refrigerators comprising hydrocarbon oils (predetermined base oil) (Col. 3/L. 39) and at least one aliphatic saturated branched-chain carboxylic acid monoalkyl ester represented by the formula:



wherein when R^2 is hydrogen, R^1 is a branched-chain alkyl and R^3 is C_1-C_{20} straight-chain alkyl (monoesters of a monobasic fatty acid having 12 or more carbon atoms and a monohydric alcohol having 1-24 carbon atoms (Col. 2-3/L. 64-15). The composition of Kawahara may further contain other base oils such as alicyclic dicarboxylic acid esters

esterified by monohydric alcohols (Col. 14/L. 21-26 and Col. 15-16/L. 55-3) (as recited in claim 12) and polyalkylene glycols (as recited in claims 13 and 16) (Col. 14/L. 24).

The finished composition of Kawahara further discloses additives such as antioxidants, metal deactivators and antiwear agents such as tricresyl phosphate (phosphorus additive as recited in claims 14 and 17).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawahara.

Kawahara discloses the limitation of claim 10 as discussed above and further discloses that the ratio of aliphatic saturated branched-chain carboxylic acid monoalkyl ester to hydrocarbon oil is 0.5:99.5 wt% to 99.5:0.5 wt% (which overlaps with the range as recited in claim 11).

9. Claims 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawahara in view of Shimomura et al., US Patent No. 6,228,282 (hereinafter referred to as Shimomura).

Kawahara discloses all of the limitations as applied to claims 13 and 16 as discussed above. Kawahara discloses antiwear agents which include phosphate and phosphite compounds, and Kawahara further discloses the use of sulfur-based additives. Kawahara, however, does not explicitly disclose the use of a phosphorothionate and a phosphorus additive apart from the phosphorothionate.

Shimomura discloses a refrigerator oil composition comprising an alicyclic polycarboxylic acid ester compound, an epoxy compound and additives which improve wear resistance and load capacity such as phosphoric esters (phosphorus compound) and sulfur compounds to further improve wear resistance and load capacity such as phosphorothionates (Col. 7-8/L. 16-31). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the composition of Kawahara with the phosphorothionates of Shimomura in order to enhance the wear resistance and load capacity of the composition (Col. 8/L. 18-20 of Shimomura).

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 10-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/565,739. Although the conflicting claims are not identical, they are not patentably distinct from each other.

The copending application claims a refrigerating machine oil composition comprising a base oil, a phosphorus-based extreme pressure agent and an oil agent (ester additive wherein the ester additive is monoesters of a monobasic fatty acid having 12 or more carbon atoms as recited in claim 10). The base oil contains at least one of an ester of polyhydric alcohols and monobasic fatty acids or an ester of alicyclic dibasic acids and monohydric alcohols (as recited in claim 12). Also, the phosphorus-based extreme pressure agent is a phosphorothionate and another phosphorus compound is used in the composition that is separate from the phosphorothionate (as recited in claims 14-15 and 17-18). The oil agent is an ester oil agent and can be one of esters of monobasic acids and monohydric alcohols or esters of linear dibasic acids and monohydric alcohols (as recited in claim 10). The monobasic acids have to have more than 12 carbon atoms and the ester additive is present in the range between 0.01-10

wt% based on the total weight of the composition (as recited in claim 11). Furthermore, the copending application further comprises an epoxy compound (alkylene oxide adduct of polyhydric alcohol having 3-6 hydroxyl groups wherein the alkylene oxide compounds can be epoxide compounds as recited in claims 13-16). The instant application recites a refrigerating machine oil composition comprising a predetermined base oil, at least one ester additive wherein the ester additive is monoesters of a monobasic fatty acid having 12 or more carbon atoms present in a range from 0.01 to 10 mass%. The base oil is an ester of an alicyclic dibasic acid and a monohydric alcohol. The composition further comprises an alkylene oxide adduct of polyhydric alcohol having 3-6 hydroxyl groups wherein the alkylene oxide compounds can be epoxide compounds (Para. [0170] of the instant application), a phosphorus additive and a phosphorothionate additive which is separate from the phosphorus additive. Therefore, the co-pending application renders the instant application obvious in terms of scope of claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

12. There were X references disclosed in the PCT search report that was part of the file wrapper to this application that were unused. This is because the references used were sufficient to reject the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VISHAL VASISTH whose telephone number is (571)270-3716. The examiner can normally be reached on M-R 8:30a-5:30p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571)272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VVV

/Glenn A Caldarola/
Acting SPE of Art Unit 1797